

## REMARKS

The specification has been amended to correct the typographical error noted by the Examiner.

The Examiner rejected independent Claim 1 as being obvious in view of the combined teachings of the Finley et al. and Bainbridge et al. references. This rejection is respectfully traversed.

The applicant renews its argument that the Bainbridge et al. reference is non-analogous art to the claimed invention and, therefore, should not be considered.

Although the Examiner has correctly stated the test for non-analogous art, the Examiner's application of that test to the facts of this specific application is incorrect.

The doctrine of analogous art recognizes that a person having ordinary skill cannot be reasonably expected to know of every teaching of every field of art. On the contrary, the person having ordinary skill is only aware of those teachings that are either (1) in the field of the applicant's endeavor or (2) reasonably pertinent to the particular problem with which the inventor was concerned. The intention of the doctrine of analogous art is to reflect the realities of circumstances, and further to limit the citation of references to only those to which the inventor would have reasonably had access. Thus, it would be quite unreasonable to suggest that the person having ordinary skill would be aware of (much less consider in detail) any teachings that fail to meet this well established doctrine.

In *Ex parte Boutaghou*, the Board Of Patent Appeals And Interferences stated that the "examiner asserts that the relevant field of endeavor is "ball bearing systems for rotating shafts." We disagree that the field of endeavor is so broad as to cover all ball bearings for all shafts. Further, when determining if a reference is analogous, one must consider the similarities and differences of structure and function of an invention disclosed in a reference." In this instance, the Examiner has failed to properly consider the similarities and differences of structure and function of the Bainbridge et al. reference.

Specifically, the Examiner defined the field of the applicant's endeavor as being "the field of providing a foamed padded undersurface." This interpretation is clearly

unreasonably broad in scope and contrary to the expressed teachings of both the Bainbridge et al. reference and the claimed invention. The Bainbridge et al. reference explicitly states that it "relates to the field of padding and more particularly, to the field of protective padding for sports gear." The Bainbridge et al. reference further states that the "invention involves protective padding primarily intended for use in sports gear" and that "it would preferably be easily integrated into sports gear such as jerseys, pants, and helmets as well as be adaptable for specialized uses such as removable knee and elbow pads." Nothing in the Bainbridge et al. reference suggests that the teachings therein can or should be used as part of a flooring covering or composite material, such as disclosed in the Finley et al. reference and claimed in this application. The Examiner's conclusory statement is completely unsupported by any factual basis in the record. Accordingly, the Bainbridge et al. reference cannot reasonably be considered to be within the field of the applicant's endeavor.

The Examiner relies upon the statement at Col. 9, Lines 60-69 of the Bainbridge et al. reference, which states that "the padding of the present invention has been primarily disclosed as adapted for use in sports gear but it is equally adaptable for use wherever foam and other padding are used. For example, the padding technology of the present invention could be used as pads for fences, poles, trees, and walls as well as in industrial applications such as elevators and vehicle bumpers." Although this statement does broaden the field of the Bainbridge et al. reference somewhat beyond the specific application disclosed therein, it cannot and does not function as a blanket expansion of the field of the Bainbridge et al. reference to every possible field of art. On the contrary, the field of the Bainbridge et al. reference is reasonably limited to what is disclosed therein. Thus, the Examiner's proposed overly broad expansion of the field of the Bainbridge et al. reference is untenable and should be withdrawn.

Additionally, the Bainbridge et al. reference is clearly not reasonably pertinent to the particular problem with which the inventor was concerned. The problems addressed by the Bainbridge et al. reference (namely, the challenges of providing a padding that can repeatedly absorb and dissipate impact forces, while still being

lightweight, breathable, washable, and easily integrated into sports gear and not unduly inhibiting an athlete's movements and dexterity on the field) are quite different from the problems addressed by the claimed invention (namely, the issues of sound absorption, low sound transmission, and moisture control).

The Examiner stated that the Bainbridge et al. reference was reasonably pertinent to the applicant's problem of "a superior padding layer (specifically of a foam padding material). This statement is not understood. As discussed in response to the previous Office Action, a "padding layer of closed-cell foam material" is not a problem - it is an article of manufacture. It is believed that the Examiner is confusing the standard of analogous art (which is focused on the problems faced by the applicant) with the standard of patentability (which is focused on the structure disclosed in the reference). The prohibition of using non-analogous art in a rejection is a threshold issue that is determined not with reference to the structures disclosed in the reference, but the problems that were faced and addressed by the reference. When viewed in this light, the use of the Bainbridge et al. reference as prior art to the claimed invention is clearly improper.

For all of the above reasons, the applicant has successfully rebutted the Examiner's *prima facie* case that the Bainbridge et al. reference is analogous art to the claimed invention. The same arguments for patentability apply to independent Claims 31 and 45 in the application, which are also patentable for the same reasons. Thus, all of such rejections should be withdrawn.

Respectfully submitted,

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